

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of: Zellner, et al.) Confirmation No: 4937
) Group Art Unit: 3622
Serial No.: 09/740,375)
) Examiner: Duran, Arthur D.
Filed: December 19, 2000)
) Atty. Docket No.: 190252-1920
For: Identity Blocking Service from a Web)
Advertiser)

APPEAL BRIEF UNDER 37 C.F.R. § 41.37

Mail Stop: Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

This Appeal Brief under 37 C.F.R. § 41.37 is submitted in support of the Notice of Appeal filed August 21, 2006, responding to the final Office Action mailed May 19, 2006.

It is not believed that extensions of time or fees are required to consider this Appeal Brief. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 C.F.R. §1.136(a), and any fees required therefor are hereby authorized to be charged to Deposit Account No. 20-0778.

I. Real Party in Interest

The real party in interest is BellSouth Intellectual Property Corporation, a Corporation of the State of Delaware, having a place of business at 824 Market Street, Suite 901, Wilmington, DE 19801.

II. Related Appeals and Interferences

There are no known related appeals or interferences that will affect or be affected by a decision in this Appeal.

III. Status of Claims

Claims 21-30 stand finally rejected. No claims have been allowed. Claims 31-40 have been withdrawn. The final rejections of claims 21-30 are appealed.

IV. Status of Amendments

This application was originally filed on December 19, 2000, with twenty (20) claims. In a Response filed June 1, 2004, Applicant amended claim 13. In a Response filed December 23, 2004, Applicant amended claims 1, 3, 5, 13, and 20. In a Response filed May 27, 2005, Applicant amended claims 1 and 13. In a Response filed November 28, 2005, Applicant canceled claims 1-20 and added claims 1-40. In a Response filed May 8, 2006, Applicant withdrew claims 31-40. The claims in the attached Claims Appendix (see below) reflect the present state of Applicant's claims.

V. Summary of Claimed Subject Matter

The claimed inventions are summarized below with reference numerals and references to the written description ("specification") and drawings. The subject matter described in the following appears in the original disclosure at least where indicated, and may further appear in other places within the original disclosure.

Embodiments according to independent claim 21 describe a method of sending an advertisement to a user operating a wireless communication device. The method comprises sending first information about a location of the user to a content provider that provides web content to the wireless communication device (Fig. 1, 10). Applicant's specification, page 15, lines 6-17 and step 76 of FIG. 4. The method further comprises sending an indication to the content provider when the location is continuously changing and searching a first database (Fig. 2, 22) containing a plurality of location-specific advertisements. Applicant's specification, pages 29-30, lines 7-13. Such a method further comprises selecting a first one of the plurality of location-specific advertisements that is associated with the location of the user and is desired to be sent to the user at a stable location that is not continuously changing and sending the first one of the plurality of location-specific advertisements to the wireless communication device (Fig. 1, 10) over a communication network (Fig. 1, 12) when the location is stable and not continuously changing. Applicant's specification, page 10, lines 10-16; pages 29-30, lines 7-13; Page 10, lines 10-16; step 78 of Fig. 4; and step 122 of Fig. 7.

VI. Grounds of Rejection to be Reviewed on Appeal

The following grounds of rejections are to be reviewed on appeal:

Claims 21 and 26 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over *Hendrey* (U.S. Patent Publication No. 2002/0102993).

Claims 22-25 and 27-30 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over *Hendrey* in view of *Goldhaber* (U.S. Patent No. 5,794,210).

VII. Arguments

The Appellant respectfully submits that Applicant's claims 21-30 are patentable under 35 U.S.C. §103. The Appellant respectfully requests that the Board of Patent Appeals overturn the final rejection of those claims at least for the reasons discussed below.

A. Rejections of Claims 21 and 26 - 35 U.S.C. §103(a)

Claims 21 and 26 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over *Hendrey* (U.S. Patent Publication No. 2002/0102993).

It is well-established at law that, for a proper rejection of a claim under 35 U.S.C. §103 as being obvious based upon a combination of references, the cited combination of references must disclose, teach, or suggest, either implicitly or explicitly, all elements/features/steps of the claim at issue. See, e.g., *In Re Dow Chemical*, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988), and *In re Keller*, 208 U.S.P.Q.2d 871, 881 (C.C.P.A. 1981).

1. The *Hendrey* Disclosure

Hendrey discloses an "Advertising tracking system 105 [that] further comprises a location tracking subsystem 132. Tracking subsystem 132 uses location information provided by telecommunication system 120 to monitor the geographic location of a plurality of [mobile telecommunication units] MUs 110 served by the telecommunication system 120. The locations may then be compared to a database of predetermined locations as beneficial to the operation of generation subsystem 131. For example, tracking subsystem 132 notifies tracking manager 130 when a user is near a particular business that desires to advertise for customers, and may also notify tracking manager 130 when a user has entered a particular business's store location." See para. 0031.

Hendrey further states: "Advertising tracking system 105 further comprises a location-sensitive advertising generation subsystem 131 that is capable of generating relevant advertising content given the location of a user and the business(es) relevant to that location. For example, if a particular user is close to a store having a sale that includes goods typically purchased by that user, generation subsystem 131 may create an advertisement stating that a particular set of goods relevant to the user is on sale at the relevant nearby store. The determination of when to send advertisements may be based on a profile associated with each user. The profile may specify the user's interests, types of advertisements he or she desires to receive, times of day that the user does/does not want to receive advertisements, and like information. The distance within which a MU must be with respect to a store before an

advertisement is fired to the MU may be any predetermined distance, for example fifty meters, and may vary by MU, by store, or the like." See para. 0032.

2. Applicant's Claim 21

Applicant's independent claim 21 provides as follows:

A method of sending an advertisement to a user operating a wireless communication device, comprising:

sending first information about a location of the user to a content provider that provides web content to the wireless communication device;

sending an indication to the content provider when the location is continuously changing;

searching a first database containing a plurality of location-specific advertisements;

selecting a first one of the plurality of location-specific advertisements that is associated with the location of the user and is desired to be sent to the user at a stable location that is not continuously changing; and

sending the first one of the plurality of location-specific advertisements to the wireless communication device over a communication network when the location is stable and not continuously changing.

(Emphasis added).

Applicant respectfully submits that independent claim 21 is allowable for at least the reason that *Hendrey* does not disclose, teach, or suggest at least the features of "sending an indication to the content provider when the location is continuously changing . . . selecting a first one of the plurality of location-specific advertisements that is associated with the location of the user and is desired to be sent to the user at a stable location that is not continuously changing; and sending the first one of the plurality of location-specific advertisements to the wireless communication device over a communication network when the location

is stable and not continuously changing," as recited and emphasized above in claim 21.

Rather, *Hendrey* discloses: "Advertising tracking system 105 [that] further comprises a location tracking subsystem 132. Tracking subsystem 132 uses location information provided by telecommunication system 120 to monitor the geographic location of a plurality of [mobile telecommunication units] MUs 110 served by the telecommunication system 120," as stated above. The Office Action mailed February 6, 2006, states that "Hendrey does not explicitly disclose that the advertisements are sent when the user's location is stable. However, Hendrey discloses tracking the user being both moving and stable (see above citations), that particular indications concerning advertisements can be made when the user's location is stable at certain areas ([47]), that the various features and embodiments of the Hendrey disclosure can be utilized for targeting advertisements ([53]), that there are many variations and factors for targeting a user [(32, 33, 34, 58)] and that there are many possible variations of the Hendrey disclosure ([66])." Pages 3-4. The Office Action therefore alleges that it would be obvious for the information in Hendrey's Fig. 1, including whether the user is moving or the location is stable, to be utilized for targeting the user. See page 4. Applicant respectfully disagrees.

For example, with respect to Fig. 1 of *Hendrey*, it shows an MU 110, a store 100, a telecommunication system infrastructure 120 with processor 107, prospect tracking manager 130, location sensitive advertising content generator 131, location tracking subsystem 132, and advertising effectiveness database

133. This by itself does not suggest or teach tracking a location of a user, determining whether the location is constantly changing, and sending advertisements which are desired to be sent when the location is determined to be stable and not constantly changing. Regarding paragraphs 0053 and 0066 cited above, they do not disclose tracking when the user's location is constantly changing or stable. Regarding paragraph 0058 cited above, it discusses identifying distances and "whether a particular user is close enough to a predetermined location to be likely to respond to an advertisement." As such, this passage does not disclose tracking when the user's location is constantly changing or stable. Regarding paragraphs 0032-0034 cited above, these passages discuss the distance within which an MU is within a store before an advertisement is sent. Regarding paragraph 0047 and gauging responsive to advertising content (see paras. 0045-0046), paragraph 0047 states:

A first technique is to monitor the general location of MU 110 over a period of time to see if traveling of the prospect ceased in the general vicinity of store 100 even if insufficient positioning accuracy is available to determine whether the prospect visited the store or merely stopped nearby it. This provides suggestive evidence that the advertisement caused the user of MU 110 to stop and shop at store 100 even if no purchase is recorded or there is insufficient information to tie a purchase to the user of MU 110. Preferably, such cessation of motion is screened for false alarms if the area in which such cessation took place was historically common, for example indicating the location of the user's work or home location.

This fails to teach or contemplate suggesting "selecting a first one of the plurality of location-specific advertisements that is associated with the location of the user and is desired to be sent to the user at a stable location that is not continuously changing; and sending the first one of the plurality of location-specific

advertisements to the wireless communication device over a communication network when the location is stable and not continuously changing," as recited in claim 21. Further note that paragraph 0053 referenced previously states, "Another variant of the embodiments discussed above is a system that creates and sends advertising content, but does not track the effectiveness of advertising (i.e., incorporates the elements of FIG. 1 except for effectiveness database 133, and has an operation corresponding only to steps 201, 202, and 210 in FIG. 2)." Thus, a system described in paragraph 0053 is a system that sends advertising content in a manner described with respect to FIG. 1, but does not include the tracking steps with respect to tracking effectiveness of advertising, such as that described with respect to paragraph 0047.

Hendrey describes the sending of advertisements based on proximity of a MU to a store or other location. *Hendrey* provides no suggestion or teaching for sending of advertisements based on whether a location of a MU or user is constantly changing. Although *Hendrey* may evaluate the effectiveness of a previously sent advertisement by examining whether traveling of a MU has ceased at a location, this is distinct from the methodology taught by *Hendrey* for sending advertisements. Accordingly, the requisite motivation for modifying the *Hendrey* reference is believed to be lacking.

Applicant submits that a *prima facie* case of obviousness has not been established, since a reference has not been cited that discloses at least "selecting a first one of the plurality of location-specific advertisements that is associated with the location of the user and is desired to be sent to the user at a stable location that

is not continuously changing; and sending the first one of the plurality of location-specific advertisements to the wireless communication device over a communication network when the location is stable and not continuously changing," as recited in claim 21. The Office Action states that it would be obvious to modify the *Hendrey* reference to include a claimed limitation without providing any support to show that the claimed limitation has been previously disclosed or is known. It is noted "To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art." *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974); see also MPEP 2143.03. Further to establish a *prima facie* case of obviousness, "impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art."

As such, *Hendrey* fails to establish a *prima facie* case of obviousness, and the rejection of claim 21 and claim 26 which depends therefrom should be withdrawn, for at least this reason. Applicant respectfully submits that the features of claims 21 and 26 have not been taught or suggested by the cited art in the manner claimed.

B. Rejections of Claims 22-25 and 27-30 - 35 U.S.C. §103(a)

Claims 22-25 and 27-30 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over *Hendrey* in view of *Goldhaber* (U.S. Patent No. 5,794,210). It is well-established at law that, for a proper rejection of a claim under 35 U.S.C. §103 as being obvious based upon a combination of references, the

cited combination of references must disclose, teach, or suggest, either implicitly or explicitly, all elements/features/steps of the claim at issue. See, e.g., *In Re Dow Chemical*, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988), and *In re Keller*, 208 U.S.P.Q.2d 871, 881 (C.C.P.A. 1981).

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Hendrey further states: "Advertising tracking system 105 further comprises a location-sensitive advertising generation subsystem 131 that is capable of generating relevant advertising content given the location of a user and the business(es) relevant to that location. For example, if a particular user is close to a store having a sale that includes goods typically purchased by that user, generation subsystem 131 may create an advertisement stating that a particular set of goods relevant to the user is on sale at the relevant nearby store.

The determination of when to send advertisements may be based on a profile associated with each user. The profile may specify the user's interests, types of advertisements he or she desires to receive, times of day that the user does/does not want to receive advertisements, and like information. The distance within which a MU must be with respect to a store before an advertisement is fired to the MU may be any predetermined distance, for example fifty meters, and may vary by MU, by store, or the like." See para. 0032.

2. The *Goldhaber* Disclosure

Goldhaber discloses various advertising approaches. For example:

To show how the approaches discussed above transform a typical advertising transaction, consider a brief scenario starring "Cynthia," an Internet surfer who has recently signed on to the service provided in accordance with the present invention.

Upon logging on to her customized home page, Cynthia would be presented with a list of ads that she may elect to view. The ads would be preselected for her on the basis of a personal profile questionnaire that she has completed plus automatic tracking of her previous Internet usage. For example, today's list might contain ads for medium-price hotels in Mazatlan (where Cynthia is planning a vacation), a do-it-yourself telescope kit (a possibility for her son's upcoming birthday), San Francisco Forty-Niner football tickets (she's a fan), new nonfat organic dessert items (she's on a diet), and heavy equipment for earth moving (she is part-owner of a construction company). In the system provided by the present invention, not only are the subjects of the ads keyed to Cynthia's interests, but certain aspects of their style, depth, and content can also be customized to her as well. For example, Cynthia's love of sunsets, independent rock groups, and dancing (all available from her profile) can be used to customize ads so that she will enjoy them more. This marks another important change from prior practice in the advertising business.

Next to some of the titles on the ad list displayed to Cynthia is the image of a little gold coin--a "consumer interface button" or

"CyberCoin"--with a distinctive style. When Cynthia clicks her mouse on the CyberCoin, it opens up the ad and simultaneously causes a transfer of cash or credit directly to Cynthia's desktop (or to a specialized account, credit card or bank account associated with her). This gives Cynthia an important incentive to watch the ad. The ad can include some degree of interactivity (e.g., Forty-Niners game stadium seating preference, choice of diet dessert, etc.) to allow the service to give the advertiser a guarantee that Cynthia paid attention to the ad. This interactivity can make the ad more fun (e.g., by providing a guessing game, quiz or joke).

The ad might ask Cynthia if she is interested in having the merchant contact her directly, and can include another CyberCoin that compensates Cynthia for the informing the merchant of her identity. Cynthia can be given the choice of whether her identity is to be released--thereby protecting her privacy.

Col. 7, lines 22-67.

3. Applicant's Claims 22-25 and 27-30

Because independent claim 21 is allowable over the cited art of record, dependent claims 22-25 and 27-30 (which depend from independent claim 21) are allowable as a matter of law for at least the reason that dependent claims 22-25 and 27-30 contain all the features of independent claim 21 and the cited art of *Goldhaber* fails to remedy the deficiencies of the *Hendrey* reference (as exemplified by the above excerpt from *Goldhaber*) . See *In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988). Additionally and notwithstanding the foregoing reasons for allowability of claims 22-25 and 27-30, these claims recite further features and/or combinations of features (as is apparent by examination of the claims themselves) that are patentably distinct from the cited art of record.

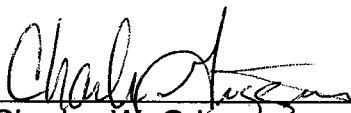
Applicant respectfully submits that the features of claims 22-25 and 27-30 have not been taught or suggested by the cited art in the manner claimed.

VIII. Conclusion

In summary, it is Applicant's position that Applicant's claims are patentable over the applied cited art references and that the rejection of these claims should be withdrawn. Appellant therefore respectfully requests that the Board of Appeals overturn the Examiner's rejection and allow Applicant's pending claims.

Respectfully submitted,

By:



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Claims Appendix under 37 C.F.R. § 41.37(c)(1)(viii)

The following are the claims that are involved in this Appeal.

21. A method of sending an advertisement to a user operating a wireless communication device, comprising:

 sending first information about a location of the user to a content provider that provides web content to the wireless communication device;

 sending an indication to the content provider when the location is continuously changing;

 searching a first database containing a plurality of location-specific advertisements;

 selecting a first one of the plurality of location-specific advertisements that is associated with the location of the user and is desired to be sent to the user at a stable location that is not continuously changing; and

 sending the first one of the plurality of location-specific advertisements to the wireless communication device over a communication network when the location is stable and not continuously changing.

22. The method of claim 21, further comprising:

- receiving second information about the identity of the user;
- searching a second database containing a plurality of user-specific advertisements;
- identifying a second one of the plurality of user-specific advertisements;
- and
- sending the second one of the plurality of user-specific advertisements to the wireless communication device over the communication network without transmitting an indication of the identity of the user therewith.

23. The method of claim 22, wherein the second one of the plurality of user-specific advertisements is identified based on one or more criteria pre-selected by the user.

24. The method of claim 22, wherein the first one of the plurality of location-specific advertisements is identified based on one or more criteria pre-selected by the user, the one or more criteria including a preference for not receiving particular advertisements in a particular geographic region.

25. The method of claim 22, wherein the first one of the plurality of location-specific advertisements is identified based on one or more criteria pre-selected by the user, the one or more criteria including a preference for receiving particular advertisements in a particular geographic region.

26. The method of claim 21, wherein the first information about the location of the user is sent periodically.

27. The method of claim 21, further comprising:

receiving second information about the identity of the user;

accessing a second database containing a plurality of user-specific preferences;

identifying one or more preferences in the second database that are associated with the user;

selecting the first one of the plurality of location-specific advertisements based on the one or more preferences in the second database; and

sending the first one of the plurality of location-specific advertisements in the form of the first TCP/IP message to the wireless communication device without transmitting an indication of the identity of the user therewith.

28. The method of claim 27, wherein receiving the second information about the identity of the user is accomplished by obtaining the second information for a fee.

29. The method of claim 21, wherein the first information about the location of the user includes second information about the identity of the user, and wherein the first one of the plurality of location-specific advertisements is sent to the wireless communication device without transmitting an indication of the identity of the user therewith.

30. The method of claim 21, wherein the first information about the location of the user excludes second information about the identity of the user.

31. (Withdrawn) A method of sending an advertisement over a communication network to a user operating a wireless communication device, comprising:

- receiving first information about a location of the user;

- receiving second information about the identity of the user;

- receiving an indication when the location of the user is continuously changing;

- searching a database containing a plurality of location-specific advertisements;

- selecting one of the plurality of location-specific advertisements based on one or more criteria pre-selected by the user, including a criteria for sending advertisements to the user when the user's location is continuously changing;
- and

sending the one of the plurality of location-specific advertisements to the wireless communication device over the communication network without transmitting the identity of the user therewith.

32. (Withdrawn) The method of claim 31, wherein receiving the first information about the location of the user is accomplished by obtaining the first information from a service provider for the wireless communication device.

33. (Withdrawn) The method of claim 32, wherein the first information about the location of the user is obtained from the service provider for a fee.

34. (Withdrawn) The method of claim 31, wherein receiving the second information about the identity of the user includes receiving the second information from a service provider for the wireless communication device.

35. (Withdrawn) The method of claim 31, wherein selecting the one of the plurality of location-specific advertisements includes:

receiving the one or more criteria from the user;

storing the one or more criteria received from the user in the database;

and

consulting the one or more criteria while selecting the one of the plurality of location-specific advertisements from the database.

36. (Withdrawn) The method of claim 35, wherein the one or more criteria including a preference for not receiving particular advertisements in a particular geographic region.

37. (Withdrawn) The method of claim 35, wherein the one or more criteria including a preference for receiving particular advertisements in a particular geographic region.

38. (Withdrawn) The method of claim 31, further comprising allowing the user to unblock over the Internet the transmission of the identity of the user.

39 (Withdrawn) The method of claim 31, further comprising disclosing the identity of the user to an emergency service provider when the user requests emergency help.

40. (Withdrawn) The method of claim 31, wherein the one of the plurality of location-specific advertisements is sent over the communication network in the form of a TCP/IP (Transmission Control Protocol/Internet Protocol) message.

Evidence Appendix under 37 C.F.R. § 41.37(c)(1)(ix)

There is no extrinsic evidence to be considered in this Appeal. Therefore, no evidence is presented in this Appendix.

Related Proceedings Appendix under 37 C.F.R. § 41.37(c)(1)(x)

There are no related proceedings to be considered in this Appeal.
Therefore, no such proceedings are identified in this Appendix.